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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

In re Application of Dale Burns

Serial No.: 09/182,033 Group Art Unit: 2164
Filed: 10/29/98 Examiner: Kazimi, H.
For: **ELECTRONIC COUPON PROCESSING SYSTEM**

Box AF
Commissioner for Patents
Washington, D.C. 20231

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FEB 07 2002

Technology Center 2100

Dear Sir:

Enclosed please find the following:

1. Reply Brief; and
2. Certificate of Express mailing.

The Commissioner is hereby authorized to charge any fee deficiency, or credit any overpayment, to Deposit Account No. 18-1579. The Commissioner is also authorized to charge Deposit Account No. 18-1579 for any future fees connected in any way to this application. Two copies of this letter are enclosed.

Respectfully submitted,

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Registration No. 45,381
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(703) 391-2900

APPELLANT'S REPLY BRIEF
U.S. Application No. 09/182,033

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REPLY BRIEF

Dear Sir:

Applicant hereby submits this Reply Brief in response to the Examiner's Answer of
December 4, 2001.

Respectfully submitted,



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Group Art Unit: 2164

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Examiner:

Kazimi, H.

For: **ELECTRONIC COUPON PROCESSING SYSTEM**

APPELLANT'S REPLY BRIEF UNDER 37 C.F.R. § 1.193(b)(1)

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Dear Sir:

In accordance with the provisions of 37 C.F.R. § 1.193(b)(1), Appellant requests withdrawal of the final rejection and submits the following:

Appellant hereby affirms that items I- VII of, and the Appendix to, the Brief on Appeal filed September 10, 2001 remain the same. It is Appellant's understanding that there is no need to reiterate contentions and information which were set forth in the Brief on Appeal. See 62 Fed. Reg. 53,132, 53,169 (1997) ("Contentions (or information) set forth in a previously filed appeal (or reply brief) need not be reiterated in a reply brief or supplemental appeal brief.").

VIII. ARGUMENTS

Drawings

Appellant again submits that the drawing figures comply with 37 CFR §1.183(a) with

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respect to the claim language "*means for each consumer to enter unutilized coupon information from printed coupons is the only means provided for consumers to add unutilized coupon information into their consumer account*" because the "Consumer Brings Coupons" box 110 of figure 1 and the "Consumer With Coupons" box 110 of figure 3 are the *are the only consumer* inputs leading to the only arrows entering the Coupon Database 100.

In the Examiner's Answer, it is argued that element 110 is not the only input since "customer database 200 is another input leading to the arrows entering the Coupon Database 100." However, Appellant submits that the customer database 200 is under the control of the store or system administrator and *not the consumer* and cannot therefore be "a means provided for *consumers* to add unutilized coupon information into their consumer account." Instead, the input 200 cited by the Examiner's Answer refers to the disclosure, at page 8, lines 17-20, that "a store ...may include other promotions or coupons that have already been entered into the system based on the market information collected for that consumer."

In response to the newly presented argument in the Examiner's Answer that "element 110 does not indicate that the coupon is a printed coupon," Appellant submits that the Examiner is improperly arguing a grounds of objection that was not clearly stated previously since prior objections to the drawings emphasized the "*only*" aspect related to illustration of the means element. Additionally, Appellant submits that since element 110 states "Consumer Brings Coupons," it is sufficient to illustrate printed coupons because printed coupons are the ordinary and accepted way to "bring" coupons.

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With respect to the Examiner's Answer argument that the use of the term "ETC" in box 120 teaches away from "means for each consumer to enter unutilized coupon information from printed coupons is the only means provided for consumers to add unutilized coupon information into their consumer account," Appellant submits that the disclosure related to data input 120 states: "The data input **120** may be done manually or electronically, such as by scanning the UPC barcodes. The data includes, but is not limited to, the product type, size, expiration date of the coupon, amount of discount, special conditions and the like" at page 10, lines 7-9. As such, "ETC" clearly refers to *data* such as the product type, size, amount of discount, special conditions and the like.

With respect to the teaching of page 12, line 11, that consumer can "*receive* coupons by electronic means, or any other method," Appellant submits that the channel that a consumer *receives* a coupon, such as by e-mail or the Internet, does not alter the fact that a consumers must, in accordance with the definition of coupon at page 6, line 8, "bring proof back to the store," which one of ordinary skill in the art understands means printing out an electronically delivered coupon.

Additionally, the fact that Appellant has limited the claims to coupons that a consumer a consumer can bring with them in *printed form* does not alter the fact that Appellant's specification and drawings disclose that said at least one *means for each consumer to enter unutilized coupon information* is the only means provided in the specification and drawings for *consumers* to add unutilized coupon information into their consumer account.

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And finally, Appellant reiterates that if only one path is illustrated from *the consumer with coupons to the database*, as in figures 1 and 3, it is unclear how else an "only means" could be illustrated.

Specification - 35 USC §112 Written Description

Appellant again submits that the specification provides adequate written description to support "wherein...means for each consumer to enter unutilized coupon information from printed coupons is the only means provided for consumers to add unutilized coupon information into their consumer account" in claims 30-39 and "wherein consumers are limited to adding unutilized coupon information into their consumer account solely from printed coupons in their possession" in claims 40-49. The written description providing support for this aspect of the present invention is found primarily in the explicit definition of coupons found on page 6:

"The term coupons, as used herein, shall mean any mode of communication with a consumer or a potential consumer offering a specific discount to the consumer *wherein the consumer needs to bring such proof back to a store* for redemption." Emphasis added.

By defining the term coupon in such a manner, other means of entering coupon information into the database are thereby eliminated, since a coupon, by definition, must be capable of being brought with the consumer.

The argument "In response to b):" in the Examiner's Answer seems to imply that the language "one of the options" in the specification means that other means for consumer input of

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unutilized coupon information beyond those in the consumer's possession have been disclosed.

This is an erroneous implication. With respect to alternate embodiments, the specification states:

1 - "The database can be built through manual entry although it is preferred that electronic scanning means be used. *One of the options* contemplated by the present invention is that a consumer *selects the coupons and brings* them to a data processing center in the store or at any other convenient location. *At the processing center, the coupon information is entered into the database and* attributed to the particular consumer. Based on technology available today, *one of the easier means of entry of the data would be through scanners* that would read the barcodes off the coupons. *Manual entry of the information is also contemplated.* The important factor is that the coupon data is entered into a database and attributed to a particular account for a particular consumer."

2 - "Figure 1 illustrates *one embodiment* of the present invention showing the operation and creation of a coupon database **100**. The *consumer brings the coupons 110 to a coupon processing center*. The coupon processing center may be located in the store, outside the store, or at any other remote location. The *data on the coupons is input at the coupon processing center* with the entry of the consumer identification. The data input **120** may be done *manually or electronically, such as by scanning the UPC barcodes*. The data includes, but is not limited to, the product type, size, expiration date of the coupon, amount of discount, special conditions and the like."

3 - "Figure 3 illustrates the architecture of *an embodiment* of the present invention. In accordance with this embodiment, the *consumer brings the coupons*

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to a coupon processing center 110. The coupon information and the consumer ID are input into a coupon database 100 and a consumer database 200."

In each of the "embodiments" 1-3 above, the coupons are brought in by the consumer to a processing center where they are entered manually or electronically into the database. No "options" or "embodiments" are disclosed or suggested wherein *consumers* can add coupons *other than those in their possession* to the database. As such, a coupon processing center for COUPONS BROUGHT IN BY THE CONSUMER is the ONLY disclosed means for CONSUMERS to add coupon data to their account.

Claim Rejections - 35 USC §112 Written Description

Appellant submits that the subject matter of claims 30-49 has been described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor, at the time the application was filed, had possession of the claimed invention for the reasons cited in the preceding paragraphs.

Claim Rejections - 35 USC §112 Definiteness

Appellant gratefully acknowledges the withdrawal of this ground of rejection.

Claim Rejections - 35 USC §103

Claims 30-49 were rejected as being obvious in view of Nichtberger et al. in view of De Lapa et al.

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To establish a *prima facie* case of obviousness, three basic criteria must be met (See M.P.E.P. Section 2143). First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988); *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).

Second, there must be a reasonable expectation of success. This requirement is primarily concerned with less predictable arts, such as the chemical arts.

Finally, the prior art must teach or suggest each and every limitation of the claimed invention, as the invention must be considered as a whole. *In re Hirao*, 535 F.2d 67, 190 U.S.P.Q. 15 (C.C.P.A. 1976).

The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in Appellant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

In the present case, at least the first and third of these criteria have not been met in the Final Office Action.

No Motivation to Combine

First, there is no suggestion or motivation, either in the references or in the knowledge generally available to one of ordinary skill in the art, to modify the electronic coupon system of Nichtberger et al. with the paper coupon system of De Lapa et al. in order to include that the one means for each consumer to enter unutilized coupon information from printed coupons is the

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only means provided to consumers to add unutilized coupon information to their consumer account.

As per MPEP 2141.02, a prior art reference must be considered as a whole, *including portions that would lead away from the invention*. *W. L. Gore and Associates, Inc. v. Garlock, Inc.*, 220 USPQ 303 (Fed Cir. 1983). In the present case, Nichtberger et al. cannot be used to render the present claims obvious under 35 USC §103 because, *as a whole*, it teaches away from the present invention.

Although col. 29, lines 56-68 suggest the *addition of a paper coupon scanner to the system of Nichtberger et al.*, the primary purpose of the Nichtberger et al. patent is to *distribute and redeem coupons electronically with a paperless system*. To accomplish this, customers make an electronic selection of coupons from a display. Therefore, *to eliminate the electronic selection of coupons by customers as a distribution means, as would be necessary to make such an obviousness rejection, would destroy the primary purpose of the Nichtberger et al. patent* and make it unsatisfactory for electronic coupon distribution. As such, the rejection is improper for failing to consider the reference as a whole. It is also improper in accordance with M.P.E.P. 2143.01 as lacking a suggestion or motivation to modify the reference *in the manner suggested by the rejection* since to do so would render Nichtberger et al. unsatisfactory for its intended purpose of electronic coupon distribution.

The secondary reference, De Lapa et al., fails to teach or suggest anything that would correct this deficiency in Nichtberger et al.

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De Lapa et al. was relied on in the rejection for teaching "that the one means for each consumer to enter unutilized coupon information from printed coupons is the only means for consumers to add unutilized coupon information into their consumer account." However, the cited portion of De Lapa et al., as well as the rest of the reference, fails to disclose or teach that consumers can add unutilized coupon information to their accounts. The only scanning involved with De Lapa et al. is related to redemption, *not adding unutilized coupon information by consumers to their accounts*. Scanning at checkout is a utilization of a coupon, so it would comprise a scanning of *utilized* coupon information.

De Lapa et al. discloses a focused coupon system wherein a database with demographic-type information is used to generate a set of coupons for a particular consumer, the coupons are printed and sent to the consumer, and, upon consumer use of the coupons, encoded redemption information is collected and used to generate the next set of coupons for the consumer. Consumers in the system of De Lapa et al. *have no means whatsoever for adding unutilized coupon information to their file in the database; all coupon generation is done by the system*. Indeed, the only scanning of UPC codes in De Lapa et al. is in the traditional way ordinary paper coupons are scanned at checkout.

The end result of the system of De Lapa et al. is *paper coupons for redemption at a point-of-sale*, which is exactly the result that the primary purpose of Nichtberger et al. *seeks to eliminate*. Since De Lapa et al. fails to teach or suggest limiting consumer addition of unutilized coupons to their accounts to scanning of paper coupons, and the teaching of *producing paper*

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coupons in De Lapa et al. directly contradicts the primary purpose of *eliminating paper coupons* in Nichtberger et al., Appellant respectfully submits that there is no suggestion or motivation, either in the references or in the knowledge generally available to one of ordinary skill in the art, to modify the electronic coupon system of Nichtberger et al. with the focused paper coupon system of De Lapa et al. in order to include that the one means for each consumer to enter unutilized coupon information from printed coupons is the only means provided to consumers to add unutilized coupon information to their consumer account.

All Claim Limitations Not Shown

None of the cited references disclose that the means for each consumer to enter unutilized coupon information from printed coupons is the only means provided to consumers to add unutilized coupon information to their consumer account, as presently required by the claims.

In view of the above arguments, Appellant respectfully submits that claims 30-49 are novel and non-obvious over Nichtberger et al. in view of De Lapa et al.

With respect to the arguments "In response to e):" in the Examiner's Answer, Appellant submits that the portion of the argument related to §112 and the assertion that the "De Lapa et al. reference need not to be introduced" to show the "only means" limitation is completely erroneous and contrary to the M.P.E.P., which at §2173.06 specifically states that "All words in a claim must be considered in judging the patentability of a claim against the prior art. *In re Wilson*, 424 F2d. 1382, 165 USPQ 494."

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Further in view of Official Notice

Further, claims 36 and 46 were rejected as being obvious over Nichtberger et al. in view of De Lapa et al., and further in view of Official Notice that "printing an aisle location on a coupon is old and well known in the art."

With respect to the arguments "In response to f):" in the Examiner's Answer, Appellant submits that the Office Actions and Examiner's Answer have erroneously taken Official Notice of the incorrect limitation of "printing an aisle location on a coupon is old and well known in the art" and not to a teaching of the correct *missing claim limitation* of "providing a *printout of the aisle locations for products* associated with a consumer's unutilized coupon information."

With respect to the statement that Appellant did not "seasonably" challenge the Official Notice, Appellant respectfully submits it is unnecessary to challenge an Official Notice that takes notice of the incorrect subject matter. Note that the claim limitation is for *a printout* (singular) of aisle *locations* (plural) for *products* (plural). Appellant submits that the printing on a coupon of an aisle location does not teach or suggest the claimed limitation since a primary purpose of the present invention is the elimination of paper coupons such that a printout is clearly different than a printed coupon. As such, Nichtberger et al. in view of De Lapa et al., and further in view of Official Notice fails to teach or fairly suggest the claimed limitation. Appellant also submits that claims 36 and 46 already depend on claims that are allowable for the reasons stated above with respect to Nichtberger et al. and De Lapa et al.

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With respect to the arguments "In response to g):" in the Examiner's Answer, claims 38 and 48 were rejected as being obvious over Nichtberger et al. in view of De Lapa et al., and further in view of Official Notice that "reviewing coupons through the Internet is old and well known in the art," Appellant acknowledges that the Official Notice was not seasonably challenged and that the newly cited reference to Christensen teaches, in a broad sense, Internet review of coupons, albeit as a 103/102(e) type reference that makes it unlikely that it was "old and well known in the art" at the time Appellant filed the present application. Additionally, claims 38 and 48 are drawn to "providing Internet review of unutilized coupon information in a consumer's consumer account based on input of said consumer's consumer identification means."

However, Official Notice has only been taken for "reviewing coupons through the Internet." As a whole, Christensen teaches online review of available discounts (unutilized coupons *not yet in the consumer's* account) and selection of coupons for redemption (adding, *not reviewing*, utilized coupons to their account) and teaches against the present invention as it is drawn to *electronic selection of coupons*. Appellant also submits that claims 38 and 48 already depend on claims that are allowable for the reasons stated above with respect to Nichtberger et al. and De Lapa et al.

Accordingly, Appellant respectfully submits that claims 20-49 are novel and non-obvious over Nichtberger et al. in view of De Lapa et al.

IX. CONCLUSION

For the above reasons, Appellant respectfully submits that the Application conforms to the requirements of 35 U.S.C. §112 and that the Final Office Action of May 9, 2001 and Examiner's Answer of December 4, 2001 have failed to make out a *prima facie* case of obviousness with regard to claims 30-49, and therefore asks that the inadequate written description rejection, the indefiniteness rejection, and the obviousness rejections be reversed.

The present Reply Brief is being filed in triplicate.

Appellant hereby petitions for any extension of time that may be required to maintain the pendency of this case, and any required fee for such extension is to be charged to Deposit Account No. 18-1579.

Respectfully submitted,



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